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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,590	09/04/2001	Yuji Sezai	110537	1660

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EXAMINER
KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
1755	11

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary	Application No.	Applicant(s)	
	09/944,590	SEZAI ET AL.	
	Examiner	Art Unit	
	C. Melissa Koslow	1755	

-- The MAILING DATE of this communication appears on the cover sh t with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-5,8-10 and 13-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-5,8-10 and 13-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This action is in response to applicants' amendment of 11 July 2003. The rejections over claims 1, 2, 6 and 7 are withdrawn due to the amendment to the claims. The 35 USC 102(b) rejection over JP 10-335130 and the art rejections over Takeda et al are withdrawn due to the amendment to the claims. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 8 and 13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent 6,423,243.

Example 1 of this reference teaches a magnetic core having a main component comprised of 24 mol% MnO, 23 mol% ZnO and 53 mol% Fe_2O_3. Since the taught composition falls within the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which falls within the claimed range, absent any showing to the contrary. The claimed core and composition clearly read upon that those taught.

The translation of the priority document for this application is acknowledged. The translation does not overcome this rejection because U.S. Patent 6,423,243 has an effective filing date of 12 September 2000, which is before applicants' effective filing date of 14 September 2000. The rejection is maintained.

Claims 5, 10 and 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent 6,217,789.

This reference teaches a magnetic core having a main component comprised of 22-25 mol% MnO, 22-25 mol% ZnO and the remainder is Fe_2O_3. Samples 1-3 and 16-20 teach compositions that fall within the compositions of claims 5 and 10. Since the taught composition falls within the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which falls within the claimed range, absent any showing to the contrary. The claimed core and composition clearly read upon that those taught.

Claims 3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 6-263447.

The abstract for this reference teaches a Mn-Zn ferrite having a main component comprised of 52.5-53 mol% Fe_2O_3, 22-25 mol% ZnO and the remainder is MnO, which is 22-25.5 mol%. The composition of examples 7 and 12 in the table on page 3 all fall within the composition of claim 3. The composition of example 9 in the table on page 3 all fall within the composition of claim 5. The claimed composition clearly reads upon that taught.

Claims 3, 8 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 11-302069.

This reference teaches a magnetic core having a main component comprised of 51-54 mol% Fe_2O_3, 20-25 mol% ZnO and the remainder is MnO, which is 20-29 mol%. The composition of example 1 of JP 11-302069, which is 23.8 mol% MnO, 24 mol% ZnO and 52.2 mol% Fe_2O_3, falls within the composition of claims 3 and 8. Since the taught composition falls within the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which falls within the

claimed range, absent any showing to the contrary. The claimed core and composition clearly read upon that those taught.

Claims 5, 10 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 10-72217.

This reference teaches a magnetic core having a main component comprised of 52.5-53 mol% Fe_2O_3, 22-25 mol% ZnO and the remainder is MnO, which is 22-25.5 mol%. The composition of the cores in example 9 in table 1 falls within the composition of claims 5 and 10. Since the taught composition falls within the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which falls within the claimed range, absent any showing to the contrary. The claimed core and composition clearly read upon that those taught.

Applicants argue the intended use of the claimed composition and core. This argument is not convincing since intended use of a claimed product does not obviate anticipation. *In re King* 231 USPQ 136 (Fed. Cir. 1986). In addition a statement of intended use in a claim preamble is given little weight in determining anticipation unless it gives life and meaning to the claim. *Diversitech Corp v. Century Steps* 7 USPQ 2d 1315 (Fed. Cir. 1988); *In re Stencil* 4 USPQ 2d 1071 (Fed. Cir. 1987). As discussed in the previous action, the phrase "for an xDSL transformer" does not impart any specific structure to the core and thus it does not give life and meaning to the claim. With respect to the argument of the optimized total harmonic distortion, this property is not claimed in claims 3, 5, 8 and 10. Thus this argument does not overcome the rejection. For claims 13 and 15, applicants have not shown the taught compositions, which fall within the

claimed composition, does not inherently have a total harmonic distortion that does not fall within the claimed range. The rejections are maintained.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-263,447.

As stated above, this reference teaches a Mn-Zn ferrite having a main component comprised of 52.5-53 mol% Fe_2O_3, 22-25 mol% ZnO and the remainder is MnO, which is 22-25.5 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed compositions.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-335130.

The abstract for this reference teaches a Mn-Zn ferrite having a main component comprised of 20-30 mol% MnO, 10-35 mol% ZnO and the remainder is Fe_2O_3, which is 35-70 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed compositions.

Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-72217.

As stated above, this reference teaches a magnetic core having a main component comprised of 52.5-53 mol% Fe_2O_3, 22-25 mol% ZnO and the remainder is MnO, which is 22-25.5 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which overlaps the claimed range, absent any showing to the contrary. The reference suggests the claimed cores and compositions.

Claims 3-5, 8-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-302069.

As stated above, this reference teaches a magnetic core having a main component comprised of 51-54 mol% Fe_2O_3, 20-25 mol% ZnO and the remainder is MnO, which is 20-29 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the taught composition overlaps the claimed composition, one of ordinary skill in the art would expect the taught composition to inherently have a total harmonic distortion at 5 kHz which overlaps the claimed range, absent any showing to the contrary. The reference suggests the claimed cores and compositions.

Applicants' arguments have been considered, but there has been no showing that the optimized total harmonic distortion is unexpected, nor have they shown that this property is not a result-effective variable. The fact the references do not measure this property does not overcome the rejections since this property is an inherent property in the taught ferrite composition. The rejections are maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
July 18, 2003

C. Melissa Koslow
Primary Examiner
Tech. Center 1700